

Case 4:08-mc-00023-TCK-PJC Document 34 Filed in USDC ND/OK on 11/06/08 Page 1 of 4

As part of its defense of the action ClimateCraft claims the asserted patents are invalid based on prior art related to air handler systems on the market in the U.S. before the filing date from which Huntair's patents claim priority. ClimateCraft contends that AAON has manufactured prior art air handling systems of the same general type as those at issue in the pending lawsuit. ClimateCraft has served AAON with two subpoenas. The first, issued August 13, 2008, seeks documents related to AAON air handler systems "designed, proposed, sold, offered for sale or manufactured by AAON prior to March 20, 2003." Motion to Compel [Dkt. # 2] at 2. The second, issued August 28, 2008, is a Subpoena Duces Tecum directing that AAON produce a corporate representative to testify about the items set forth in the first subpoena as well as other topics. (AAON's Ex. #2 at the October 30, 2008, hearing). ClimateCraft's Motion to Compel relates only to the document subpoena; AAON's Motion to Quash/Modify relates to both subpoenas.

AAON contends the information sought is trade secrets and that disclosure will cause the company irreparable harm, even if produced pursuant to a protective order. AAON asks that the subpoenas be quashed or modified to restrict disclosure to information already known to the industry and the identification of documents submitted to the U.S. Patent and Trademark Office on Nov. 19, 2004, and July 28, 2005, by AAON in opposition to Huntair's claimed patent.

Following a lengthy hearing on Oct. 30, 2008, the parties appeared to have reached an agreement narrowing the scope of the documents and testimony sought. At the parties' request, rulings on the Motion to Compel and the Motion to Quash/Modify were held in abeyance pending submission of an agreed order by Nov. 7, 2008. (*See*

Minute Sheet, Dkt. # 26). However, on Nov. 3, 2008, ClimateCraft notified the Court that the parties had been unable to reach an agreement regarding the pending motions.

In the Notice of ClimateCraft, Inc. to Court [Dkt. # 27], however, ClimateCraft greatly restricted the scope of its document and deposition subpoenas:

Based on the testimony offered at the hearing held October 30, 2008, ClimateCraft gives notice that it withdraws its subpoenas and motion to compel that seek production of records except insofar as they seek the records relating to the following five AAON systems:

- The Commons, sold to Bouis Construction Co., Princeton, New Jersey in approximately 1998;
- Borders East Tower, proposed to Borders Group, Inc. in approximately 2001;
- Farm Show Arena, proposed to Frey Lutz Corporation, Harrisburg, Pennsylvania, in approximately 2001;
- Harrison Hills, proposed to Jacob Associates approximately 2002;
- Weirton Medical Center, Weirton, West Virginia, sold to Tobey-Karg Sales Agency, Pittsburg, Pennsylvania, in 2002.

As to these five systems, ClimateCraft gives notice that it seeks only the following drawings of the type provided to AAON customers: (1) wiring diagrams showing controls for the supply and return fans; and (2) elevation and plan views showing the positioning and arrangement of the supply and return or exhaust fans (if any).

[Dkt. # 27 at pp. 1-2].

The Court conducted a telephonic hearing on Nov. 6, 2008, regarding the parties' positions on the subpoenas. AAON and ClimateCraft have reached agreement on the scope of discovery, but have reserved the issue of any award of attorney fees and costs to AAON.

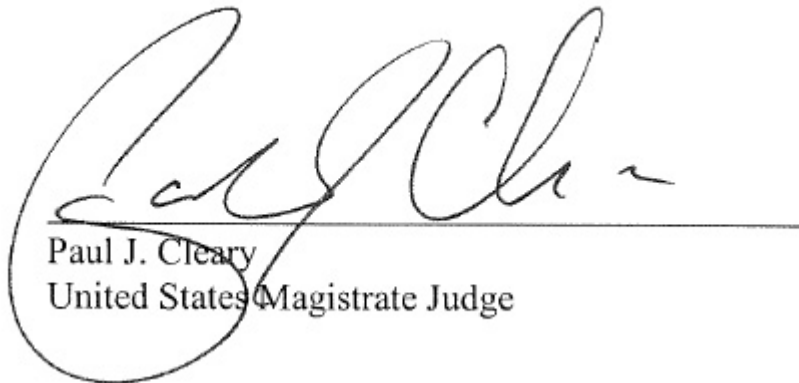
Accordingly, AAON has agreed to produce documents to ClimateCraft in accordance with the limitations set forth above and as agreed to by the parties on the record at the Oct. 30, 2008, hearing. Production will be made on or before Nov. 11,

2008. AAON will then offer David Knebel, Vice-President Sales, for deposition on Nov. 18, 2008, starting at 9:30 a.m., at the Tulsa law offices of Johnson, Jones, Dornblaser, Coffman & Shorb, 2200 Bank of America Center, 15 West Sixth Street.

THEREFORE, based upon the agreement of the parties, the Motion to Compel [Dkt. #2] and the Motion to Quash/Modify [Dkt. #7, #12] are MOOT. Discovery will proceed in accordance with the agreement outlined herein.

AAON's Motion for Attorney Fees and Expenses [Dkt. # 29] related to the deposition and document subpoenas will be addressed by the Court following ClimateCraft's response thereto.

IT IS SO ORDERED this 6th day of November 2008.



Paul J. Cleary
United States Magistrate Judge